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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,931	11/03/2003	Rhynette N. Hurd	IP022303	5940

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INTERNATIONAL PAPER COMPANY  
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EXAMINER
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CHEN, TE Y

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/700,931

Applicant(s)

HURD ET AL.

Examiner

Susan Y. Chen

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/20/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

Claims 1-19 are presented for examination.

### ***Priority***

Applicant's claim for the benefit of a prior-filed application no. 60/423,047 filed on Nov. 01, 2002 under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

### ***Specification***

The use of the trademark Lotus Notes® [e.g., Fig. 5 and associated texts] of IBM® corporation has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Objections***

Claim 13 is objected to because of the following informalities:

As to claim 13, there is a typo in line 3, the symbol “::” should be changed to “:”.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2 and 13-19, are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Publication No. 2001/0028364 of Fredell et al. (hereinafter referred as Fredell).

**Claim 1:**

Fredell discloses a method of distributing and monitoring use of electronically stored documents comprising:

electronically storing a plurality of editable form documents in a forms database [e.g., Abstract, lines 1-4, sections: 0002-0004 & 0009, 0086];

providing access, via a bi-directional communications network, to users of the forms database [e.g., the global computer network at sections: 0009, Fig. 1];

enabling each user who has obtained access to the database to view a directory of stored form documents [e.g., the Web server at sections: 0040-0043, Fig. 2];

enabling each the user to select and view at least one of the stored form documents from the directory [e.g., the virtual-network viewer/browser of sections: 0044-0047, 0088-0089, Fig(s). 3-4];

Art Unit: 2161

enabling the user to edit and retrieve an edited version or an unedited version of the document selected from the directory [e.g., section: the editor module (86, Fig. 1) at 0045 & the units: 222, 228, 234, etc Fig. 5 at 0093] ; and

identifying and storing information regarding actions taken by each user in connection with the database [e.g. sections: 0103-0129].

Claim 2:

Except the limitationss recited in claim 1, Fredell further discloses that enabling system monitor ones of the users to access the stored information regarding actions and to compile data regarding the actions [e.g., section: the global communication network enables secure document transmission between users, the integration team post merger and acquisition (M & A) compiles historical information accumulated during the due diligence process at 0008 & the usage module (52, Fig. 2) of Web server (20, Fig. 2) monitors the usage of each virtual network client actions at 0041; the integration processing done by the Acquisition Trustee system at 0103-0129].

Claim 13:

Except the limitations recited in claim 1, Fredell further discloses that the method further comprising: identifying and storing the identity of each user who obtains access to the database [e.g., sections: 0045-0046].

Claim 14:

Except the limitations recited in claim 13, Fredell further discloses that storing a first indicator with respect to each form contract each time it is viewed by a user [e.g., Fredell: the icon 101 at section 0088].

Claim 15:

Except the limitations recited in claim 14, Fredell further discloses that storing a second indicator with respect to each form contract each time it is downloaded by a user [e.g., Fredell: the icon 102 at section 0009].

Claim 16:

Except the limitations recited in claim 15, Fredell further discloses that storing a third indicator with respect to each form contract each time it is used by a user associated with a particular group [e.g., Fredell: icon 103 at sections: 0090-0092].

Claim 17:

Except the limitations recited in claim 1, Fredell further discloses the following:  
each of the stored documents comprises a form contract associated with particular operational groups within a business organization [e.g., section: the shared project calendar at 0100 & Fig. 7]; and

the database further comprises explanatory information relating to alternative provisions for the contracts [e.g., section: the hyperlink "HELP" at 0102].

Art Unit: 2161

Claim 18:

Except the limitations recited in claim 17, Fredell further discloses that enabling system monitor ones of the users to access the stored information regarding actions and to compile data regarding the actions [e.g., section: the global communication network enables secure document transmission between users, the integration team post merger and acquisition (M & A) compiles historical information accumulated during the due diligence process at 0008 & the usage module (52, Fig. 2) of Web server (20, Fig. 2) monitors the usage of each virtual network client actions at 0041; the integration processing done by the Acquisition Trustee system at 0103-0129].

Claim 19:

Except the limitations recited in claim 18, Fredell further discloses that enabling the system monitor users to retrieve reports of the actions [e.g., the integration processing done by the Acquisition Trustee system at 0103-0129].

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3-12, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2001/0028364 of Fredell et al. (hereinafter referred as Fredell) in view of U.S. Patent No. 6,654,749 issued to Nashed.

Claim 3:

Except the limitations recited in claim 1, Fredell does not specifically disclose that upon providing access by a user to the forms database, registering a hit when the user takes an action with respect to the database.

However, Nashed discloses that that upon providing access by a user to the forms database, registering a hit when the user takes an action with respect to the database [e.g., Abstract & Fig. 1 and associated texts].

Fredell and Nashed are both in the same endeavor to distribute and monitor the usage of electronically stored documents via Internet database architecture [e.g.,



Art Unit: 2161

Fredell: section 0002-0003, Fig. 1; Nashed: col. 4, line22-25, Fig. 1], thus, with the teachings of Fredell and Nashed in front of him/her, it would have been obvious for an ordinary skilled person in the art at the time the invention was made to be motivated to modify Fredell's invention with the well-known "registering a hit" of an electronic document over an open Internet database architecture as disclosed by Nashed, because by do so, as suggested by Nashed the combined invention will be upgraded to provide a search engine capable of accessing information sources whose information database have been indexed to provide high quality and high relevant information concerning a topic of interest that is identified for a search query, which automatically registers a user with an information source requiring registration for access to provide that such source can be searched and information can be retrieved therefrom without having the user provide any user identification data to such sources and which can update the search results for a search query with relative ease and minimal time expenditure by the user [e.g., Nashed: col. 2, lines 27-37].

Claim 4:

Except the limitations recited in claim 3, the combined invention of Fredell and Nashed further discloses that upon providing access by a user to the forms database, registering and storing a database hit [e.g., Nashed: Abstract, Fig. 1 and associated texts].

Claim 5:

Art Unit: 2161

Except the limitations recited in claim 4, the combined invention of Fredell and Nashed further discloses that upon registering a database hit, storing the identity of the user accessing the database [e.g., Nashed: Abstract & col. 2, lines 49-59 & Fig(s). 1-3 and associated texts].

Claim 6:

Except the limitations recited in claim 5, the combined invention of Fredell and Nashed further discloses that upon registering a database hit, storing the identity of the data of the database hit [e.g., Nashed: Abstract & col. 2, lines 64 – col. 3, lines 15; Fig(s). 1-3 and associated texts].

Claim 7:

Except the limitations recited in claim 6, the combined invention of Fredell and Nashed further discloses that upon enabling the user to select the at least one of the stored documents, registering a hit for the particular document selected [e.g., Nashed: Abstract & col. 2, lines 64 – col. 3, lines 15; Fig(s). 1-3 and associated texts].

Claim 8:

Except the limitations recited in claim 7, the combined invention of Fredell and Nashed further discloses that upon registering a hit for a particular document selected, registering a hit for a particular group with which the particular document is associated

Art Unit: 2161

[e.g., Nashed: Abstract & col. 2, lines 64 – col. 3, lines 15; Fig(s). 1-3 and associated texts].

Claim 9:

Except the limitations recited in claim 7, the combined invention of Fredell and Nashed further discloses that upon enabling the user to select the at least one of the stored documents, registering a hit for a particular organization with which the user is associated [e.g., Nashed: Abstract & col. 3, lines 11-15, Fig(s). 1-3 and associated texts].

Claim 10:

Except the limitations recited in claim 9, the combined invention of Fredell and Nashed further discloses that upon enabling a user to select and view a stored document, cross-referencing user and document data [e.g., Nashed: Abstract & col. 5, lines 7-24, Fig(s). 1-3 and associated texts] .

Claim 11:

Except the limitations recited in claim 10, the combined invention of Fredell and Nashed further discloses that upon enabling a user to retrieve a version of a document selected from the directory, recording a download hit for the document [e.g., Nashed: col. 3, lines 5-11].

Art Unit: 2161

Claim 12:

Except the limitations recited in claim 8, the combined invention of Fredell and Nashed further discloses the following:

each of the stored documents comprises a form contract associated with particular operational groups within a business organization [e.g., Fredell: the shared project calendar at section 0100 & Fig. 7]; and

the database further comprises explanatory information relating to alternative provisions for the contracts [e.g., Fredell: the hyperlink "HELP" at section 0102].

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

1) Reisman (U.S. Patent No. 6,611,862) which discloses a user station software that controls to transport and present content document from a remote source.

2) Wright et al. (U.S. Patent No. 6,581,040) which discloses systems for providing enhance communications for managing projects involving multiple resource providers.

3) Beurskens (U.S. Publication No. 2005/0114252) which discloses a system for pricing a commodity.

4) Hinde et al. (U.S. Publication No. 2002/0077826) which discloses a voice communication providing interactive voice page services among users.

Art Unit: 2161

5) Yehia et al. (U.S. Publication No. 2002/0091614) which discloses a system having method for automatic contract reconciliation in a multilateral environment.

***Points of Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y. Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Y Chen  
Examiner  
Art Unit 2161

April 21, 2006

